



Atty. Dkt. No. 029318-0976

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Ray W. WOOD et al.

Title: NANOPARTICULATE BECLOMETHASONE COMPOSITIONS

Appl. No.: 10/667,472

Filing Date: 09/23/2003

Examiner: Mina Haghigian

Art Unit: 1616

TERMINAL DISCLAIMER FOR U.S. PATENT NO. 6,811,767

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Petitioner, Elan Pharma International Ltd., having its principal place of business at Treasury Building, Lower Grand Canal Street, Dublin 2, IRELAND, represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application No. 10/667,472, filed on September 23, 2003, which is a continuation of U.S. Patent Application No. 09/577,489, filed on May 25, 2000, which is divisional of U.S. Patent Application No. 08/948,216, filed on October 9, 1997, now U.S. Patent No. 6,264,922, which is a continuation of U.S. Patent Application No. 08/589,681, filed on January 19, 1996, now abandoned, which is a continuation-in-part of U.S. Patent Application No. 08/394,103, filed on February 24, 1995. This application is owned by Elan Pharma International Ltd. by virtue of an Assignment from the inventors to Eastman Kodak Co. for Application No. 08/394,103 recorded on April 13, 1995, at Reel/Frame 007430/0713; an Assignment from the inventors to Eastman Kodak Co. for Application No. 08/589,681 recorded on January 22, 1996, at Reel/Frame 007902/0485; an assignment from Eastman Kodak Co. to Particulate Prospects Corp. recorded on February 20, 1996, at Reel/Frame 007820/0153-0159; an assignment from Particulate Prospects Corp. to NanoSystems LLC recorded on February 20, 1996, at Reel/Frame 007817/0273-0279; an assignment from NanoSystems LLC to Elan Corporation plc recorded on May 5, 2000, at Reel/Frame 010797/0486-500; and an assignment from Elan

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Corporation plc to Elan Pharma International Ltd. recorded on May 5, 2000, at Reel/Frame 010797/0501 in the United States Patent and Trademark Office.

Further, Petitioner represents that it is the owner of U.S. Patent No. 6,811,767 for "Liquid droplet aerosols of nanoparticulate drugs," which issued on U.S. Patent Application No. 09/597,738, filed on June 19, 2000, which is a divisional application of U.S. Patent Application No. 09/190,138, filed on November 12, 1998. This patent is owned by Elan Pharma International Ltd. by virtue of an Assignment from the inventors to NanoSystems LLC recorded on March 31, 1999, at Reel/Frame 009861/0227; and an assignment from NanoSystems LLC to Elan Pharma International Ltd. recorded on August 24, 2000, at Reel/Frame 011079/0301, in the United States Patent and Trademark Office.

Petitioner respectfully disagrees with the Examiner regarding the obviousness-type double patenting rejection given in the Office Action dated April 6, 2006. This Terminal Disclaimer is being filed for the sole purpose of advancing the prosecution of this case.

Petitioner hereby disclaims the terminal part of the term of any patent granted on the above-identified patent application which would extend beyond the full statutory term of U.S. Patent No. 6,811,767. In addition, Petitioner hereby agrees that any patent so granted on the above-identified patent application shall be enforceable only for and during such period that the legal title to U.S. Patent No. 6,811,767 shall be the same as the legal title to any patent granted on the above-identified patent application, this agreement to run with any patent granted on the above identified patent application and to be binding upon the grantee, its successors, or assigns.

In making this disclaimer, Petitioner does not disclaim any terminal part of any patent granted on the above identified patent application, prior to the full statutory term of U.S. Patent No. 6,811,767 as defined in 35 U.S.C. §§ 154-156 and 173, in the event that U.S. Patent No. 6,811,767 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 U.S.C. § 154, prior to the full

statutory term of U.S. Patent No. 6,811,767 as defined in 35 U.S.C. §§ 154-156 and 173, except for the separation of legal title stated above.

Further, Petitioner does not disclaim any terminal part of a patent granted on the above identified patent application that would extend beyond the present termination of U.S. Patent No. 6,811,767, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§ 155, 155A, or 156, and without waiving Petitioner's right to extend the term of a patent granted on the above identified patent application to the extent provided by law.

The undersigned, being the Attorney of Record for the above identified patent application, and duly authorized to act on behalf of Petitioner, certifies that she has reviewed the Assignments referenced herein, and to the best of her knowledge and belief, legal title to the above identified patent application and U.S. Patent No. 6,811,767 rests with Petitioner.

The undersigned declares that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date July 6, 2006

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